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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,650	03/19/2004	Michael Borns	10070485-02	9645

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EXAMINER	
STAPLES, MARK	

ART UNIT	PAPER NUMBER
1637	

NOTIFICATION DATE	DELIVERY MODE
12/23/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/805,650	**Applicant(s)** BORNS, MICHAEL	
	Examiner Mark Staples	**Art Unit** 1637	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-10,13,15,25-29 and 40-52*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Kenneth R Horlick/
Primary Examiner, Art Unit 1637

Continuation of 5. Applicant's reply has overcome the following rejection(s):

Claim Rejections Withdrawn - 35 USC § 112 First Paragraph

The rejection of claims 1-10, 13, 15, 25-29, 40, 49, and 50 under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for a range of greater than pH 12 to pH 14, is withdrawn. Applicant has overcome this rejection by amending the claims to recite a range of pH from 9.3 to 12, a range which is enabled by the specfication.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1-10,13,15,25-29 and 40-52 remain rejected as follows.

Claim Rejections Maintained - 35 USC § 103

The rejection of claims 1-4, 7-11, 13, 15, 19, 25-30, and 40-46 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) as evidenced by Dietrich et al. (2002) is maintained. Applicant's arguments filed 12/08/2008 have been fully considered but they are not persuasive.

Applicant submits that Attachment B (Ex Parte Thomas J.) supports Applicant's argument that the fusion polymerase claimed is not obvious from the fusion polymerase of Wang in regards to property of enzyme activity in the pH range of 9.3 to 12. However the decision in Ex Parte Thomas J. relies on the fact that the claimed invention had structural differences from the previously patented invention, which were not found in the previous specification of that patent, and which then imparted different and non-obvious properties to the claimed composition. Thus the claimed composition was allowable over the previously patented composition However there is no support in the instant specfication for the claimed fusion polymerase to have any structural difference from the fusion polymerase disclosed by Wang. In effect Applicant is arguing that a newly discovered property inherent to an already disclosed fusion polymerase is patentable. Discovery of a new property inherently present in the prior art does not necessarily make the claimed invention patentable (see MPEP § 2112 I.) Furthermore, the prior art supports that the property is not newly discovered, as the prior art of Wang and Dietrich make the claimed pH range obvious (see prior Office action).

Thus considering the facts and arguments, the claimed invention is obvious over the prior art and the rejection is maintained.

The rejection of claims 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) and further in view of Sanger et al. (1977) is maintained. Applicant's arguments filed 12/08/2008 have been fully considered but they are not persuasive. Applicant argues that the rejection under Wang as evidenced by Dietrich should be withdrawn. However that rejection is maintained and so this rejection is maintained.

The rejection of claims 47 and 48 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) is maintained. Applicant's arguments filed 12/08/2008 have been fully considered but they are not persuasive. Applicant argues that the rejection under Wang as evidenced by Dietrich should be withdrawn. However that rejection is maintained and so this rejection is maintained. Applicant also argues that blends of polymerases with activity at the claimed pH range are not obvious, but this has already been considered and not found to be persuasive (see previous Office action).

The rejection of claims 49-52 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) and Dietrich et al. (2002) is maintained. Applicant's arguments filed 12/08/2008 have been fully considered but they are not persuasive.

Applicant argues that Dietrich cite Gueguen (Attachment A) and asserts Gueguen teach that certatin polymerases do not maintain significant activity at pH 9-10. However the instant claims do not recite the limitation of "significant activity" and thus the teachings of Gueguen make obvious the currently claimed invention, as Gueguen necessarily teach that polymerase have some activity at pH 9-10. Further as Dietrich teach after Gueguen, Dietrich is disclosing the new teaching of some polymerases funtioning well at the claimed pH range. Thus as both Dietrich and Geuguen make obvious the claimed invention, the rejection is maintained.